

Appl. No. 09/943,904
Amdt. dated January 23, 2006
Reply to Office action of 11-30-2005

REMARKS/ARGUMENTS

Claims 1-27 are pending in the present application.

This Amendment is in response to the Office Action mailed November 30, 2005. In the Office Action, the Examiner rejected claims 1-27 under 35 U.S.C. §102(b). Reconsideration in light of the remarks made herein is respectfully requested.

Response to Examiner's arguments

1. In the Office Action, in refuting Applicants' previously filed arguments, the Examiner contends that Christeson teaches dynamically updating BIOS firmware parts that includes both normal BIOS and recovery BIOS, citing Christeson, col. 1, lines 25-45 and col. 2, lines 15-57. The Examiner states that BIOS is responsible for initializing the components of a computer system upon startup, thus updating the BIOS firmware would be adding a new initiation module to a BIOS (Office Action, Page 10, last paragraph). Applicants respectfully disagree for the following reasons. First, the BIOS firmware contained in the flash memory is fixed, occupying a fixed address range and having a fixed size (Christeson, Figure 2). Therefore, it does not have an extensible firmware architecture. Second, updating the BIOS firmware, according to Christeson's teaching, merely means modifying each of the separately programmable regions of the flash memory (Christeson, col. 2, lines 54-57), not adding a new initiation module. Modifying or updating is not the same as adding. Since Christeson does not disclose an extensible firmware architecture, it is impossible to add a new initiation module to the BIOS firmware.
2. The Examiner further contends that Christeson also teaches the verification of the flash memory area, citing Christeson col. 3, lines 26-35. However, verification simply means comparing a file against a specified memory area. If there are differences, a verification error results (Christeson, col. 11, lines 54-65). Therefore, verification is not the same as evaluating the new initiation module. Evaluation is to determine if the new initiation module is designated as recovery initialization module (See, for example, specification, paragraph [0021]). Furthermore, since Christeson does not disclose adding a new initiation module, Christeson does not disclose evaluating the new initiation module.

Appl. No. 09/943,904
Amdt. dated January 23, 2006
Reply to Office action of 11-30-2005

3. The Examiner further contends that since Christeson discloses storing BIOS instructions in the flash memory in a normal BIOS and a recovery BIOS, Christeson teaches designating recovery area of the flash memory. Applicants respectfully disagree. Dividing a BIOS into a normal BIOS and a recovery BIOS is different than designating a new initiation module as a recovery initiation module because there is no new recovery BIOS. Furthermore, since the division of the BIOS into the normal BIOS map and the recovery BIOS map is done before the update and without adding a new initiation module, it cannot designate the new initiation module as a recovery initiation module.

4. The Examiner further contends that by placing the update in the recovery BIOS as opposed to placing the update in the normal BIOS is designating the new initiation module as a recovery initiation module. However, Christeson does not teach placing the update in the recovery BIOS. The recovery BIOS is electronically protected (i.e., locked) to prevent erasure or modification (Christeson, col. 5, lines 44-46; Figure 2, element 202). Therefore, it cannot be replaced by the update.

Rejection Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,579,522 issued to Christeson et al. ("Christeson"). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a prima facie case of anticipation.

Christeson discloses a dynamic non-volatile memory update in a computer system. A flash memory device contains a normal system BIOS 201 and a recovery BIOS 202 used for recovery operation (Christeson, col. 5, lines 36-40; lines 44-46). To prevent an aborted BIOS update from rendering the computer non-functional, there are two update modes: a normal update mode and a recovery update mode (Christeson, col. 6, lines 8-12). Recovery update mode is used when a user cannot boot the system because the normal system BIOS has been corrupted following a power failure during a normal BIOS update (Christeson, col. 6, lines 27-30). A jumper is used to modify the address to configure the system to either a normal BIOS map or a recovery BIOS map (Christeson, col. 7, lines 8-15).

Appl. No. 09/943,904
Amdt. dated January 23, 2006
Reply to Office action of 11-30-2005

Christeson does not disclose, either expressly or inherently, (1) adding a new initiation module to a BIOS firmware of a computing system having an extensible firmware architecture, the BIOS firmware having a plurality of initiation modules including recovery initiation modules for recovery of the computing system and non-recovery modules, (2) automatically evaluating the initiation module; and (3) designating the new initiation module as a recovery initiation module if the new initiation module is required for the recovery of the computing system.

Christeson merely discloses two update modes, not adding a new initiation module. The recovery BIOS 202 is fixed (e.g., occupying fixed address range and having a size of 8K as shown in Figure 2 of Christeson) and is used to provide the recovery BIOS update mode. There is no new initiation module to be added to the BIOS firmware. Since the BIOS firmware contained in the flash memory is fixed, occupying a fixed address range and having a fixed size (Christeson, Figure 2), it does not have an extensible firmware architecture.

In the Office Action, the Examiner states that Christeson teaches the verification of the flash memory area which is interpreted as automatically evaluating the initiation module (Office Action, page 2, paragraph 3). Applicant respectfully disagrees. Verification of the flash memory area simply means comparing a file against a specified memory area. If there are differences, a verification error results (Christeson, col. 11, lines 54-65). Therefore, verification is not the same as evaluating the new initiation module. Evaluation is to determine if the new initiation module is designated as recovery initialization module (See, for example, specification, paragraph [0021]).

The Examiner further contends that the BIOS including both a normal BIOS in one memory block and recovery BIOS in another area of the flash memory is interpreted as designating the recovery area in the flash memory (Office Action, page 2, paragraph 3). Applicant respectfully disagrees. As discussed above, the division of the BIOS into the normal BIOS map and the recovery BIOS map is done before the update and without adding a new initiation module. Therefore, it cannot designate the new initiation module as a recovery initiation module. Furthermore, since the partitioning of the flash memory is fixed, there is no determination if an initiation is required for the recovery.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or

Appl. No. 09/943,904
Amdt. dated January 23, 2006
Reply to Office action of 11-30-2005

inherently described, in a single prior art reference.” Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the...claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir.1989). Since the Examiner failed to show that Christeson teaches or discloses any one of the above elements, the rejection under 35 U.S.C. §102 is improper.

Therefore, Applicants believe that independent claims 1, 10, and 19 and their respective dependent claims are distinguishable over the cited prior art references. Accordingly, Applicants respectfully request the rejection under 35 U.S.C. §102(b) be withdrawn.

Appl. No. 09/943,904
Amdt. dated January 23, 2006
Reply to Office action of 11-30-2005

Conclusion

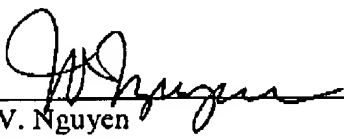
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: January 23, 2006

By


Thinh V. Nguyen

Reg. No. 42,034

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

FACSIMILE

☐ deposited with the United States Postal Service
as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

☒ transmitted by facsimile to the Patent and
Trademark Office.

Date: January 23, 2006


Tu Nguyen

January 23, 2006

Date